

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the outstanding grounds of rejection is respectfully requested in light of the above amendments and the remarks that follow.

With respect to the obviousness-type double patenting ground of rejection set out in paragraph 2 of the Official Action, applicants will abandon the copending application Serial No. 10/500,309, thereby rendering the rejection moot.

The Examiner has rejected claims 1, 3, 4 and 18 under 35 U.S.C. § 103(a) as unpatentable over Baumann in view of Beckmann and Kakehi for the reasons stated in paragraph 3 of the Official Action. By this proposed response, applicants have incorporated the subject matter of dependent claim 6 into independent claim 1, and the same limitation has been added to independent claim 18. That limitation requires the microcapsules to comprise a shell of polyoxymethylene urea (PMU). None of the three references applied by the Examiner disclose or suggest this limitation and therefore, the rejection is no longer applicable and should be withdrawn.

The Examiner rejected claim 6 under 35 U.S.C. § 103 as unpatentable over Baumann in view of Beckmann and Kakehi and further in view of Dennen. Dennen relates to a flip-open box package such as a cigarette pack, with enhanced aroma due to encapsulated flavor materials incorporated on the interior surface of the flip top. Dennen discloses that the shell surrounding the microcapsules is formed of a polyoxymethylene urea.

Insofar as the Dennen reference may now be considered by the Examiner as relevant to amended claims 1 and 18 (claim 6 has been canceled), applicants submit that the reference is not combinable with the remaining cited references under 35 U.S.C. § 103. More specifically, Dennen is not at all relevant to the claimed subject matter for the following reasons:

1. Dennen is not in the same or even remotely related art area (cigarette packaging vs. compressor piston lubrication);
2. Dennen is not at all concerned with the release of lubricants in a high temperature environment; rather, Dennen is concerned with aroma enhancement during the act of opening a cigarette pack;
3. Dennen thus does not address any problem that could in any way be considered reasonably related to the problem addressed by applicants; and
4. There is no teaching or suggestion and nor would it be predictable from the disclosure in Dennen, that the use of a microcapsule shell made of polyoxymethylene urea would be suitable for use in the compressor piston-lubrication context of the presently claimed invention.

Accordingly, one of ordinary skill in the art of compressor engineering would not have looked to Dennen for solutions to problems that are not even remotely addressed in Dennen. The Section 103 rejection is therefore improper for failing to make out a prima facie case of obviousness with respect to the subject matter of claims 1 and 18..

The Examiner has also rejected claims 11 and 12 under 35 U.S.C. § 103 as unpatentable over Baumann in view of Beckmann and Kekahi and further in view of Korshak. Claims 11 and 12 are patentable by reason of their dependence upon claim 1.

The Examiner has also rejected claims 1 and 7-10 under 35 U.S.C. § 103 as unpatentable over Baumann in view of Beckmann and Yamashita. Yamashita is cited for teaching the use of polytetrafluoroethylene as the lubricating agent. However, there is no disclosure or teaching in Yamashita of forming a microcapsule shell of polyoxymethylene urea as now required by independent claim 1. Accordingly, the rejection of claims 1 and 7-10 over Baumann in view of

Beckmann and Yamashita is also deficient for failing to establish prima facie obviousness and should now also be withdrawn.

The Examiner has also rejected claims 11 and 12 under 35 U.S.C. § 103 as unpatentable over Baumann in view of Beckmann and Yamashita and further in view of Korshak. Here again, the rejection is improper for the same reasons discussed hereinabove, noting again that claims 11 and 12 depend from independent claim 1.

It is respectfully submitted that the application is now in condition for allowance, and early passage to issue is requested. In the event, however, any small matters remain outstanding, the Examiner is encouraged to telephone the undersigned so that the prosecution of this application can be expeditiously concluded.

The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



Michael J. Keenan

Reg. No. 32,106

MJK:rrr

901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100